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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,563	06/25/2003	George D. Blankenship	LEEE 2 00197	5496
7590	06/29/2005			EXAMINER KIM, AHSHIK
FAY, SHARPE, FAGAN, MINNICH & McKEE Seventh Floor 1100 Superior Avenue Cleveland, OH 44114-2579			ART UNIT 2876	PAPER NUMBER

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/603,563	BLANKENSHIP, GEORGE D.
	<b>Examiner</b>	<b>Art Unit</b>
	Ahshik Kim	2876

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 6/25/03 (initial filing of application).

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-76 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-76 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 25 June 2003 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

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**DETAILED ACTION**

*Continuation Data*

1. Acknowledged this application is a continuation-in-part application of U.S. Serial No. 09/842,103 filed on April 26, 2001, now U.S. Patent No. 6,536,660, which is a divisional application of U.S. Serial No. 09/336,574 filed on June 21, 1999, now U.S. Patent No. 6,267,291.

*Information Disclosure Statement*

2. The information disclosure statement filed on June 25, 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Page 3 of IDS is not considered since no copies were provided. Applicant is required to submit a copy of non-patent literature or foreign patent document for consideration.

*Obviousness-Type Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

25 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-76 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14, 20, 22, 37 and 56 of US Patent No. 6,708,877 to Blankenship et al. (hereinafter “877 patent”). Both instant application and ‘877 are assigned to 10 the identical inventive entity.

Although the conflicting claims are not identical, it is the Examiner’s view that they are not patentably distinct from each other. Claim 1 of the instant application recites “A method of encoding data on a metal welding wire including the steps of: a) moving a welding wire along a path; b) providing coded information; c) providing an encoding mechanism to impart said coded 15 information on the said welding wire as said welding wire moves past said encoding mechanism.” Claim 1 of 877 patent states “A method of encoding data on a metal welding wire including the steps of: a) moving a welding wire along a path; b) providing coded information; c) providing an encoding mechanism along said path to impart the coded information on to said welding wire, said coded information includes at least one code segment of one of a pulse count, 20 a pulse width, a pulse frequency, a program, a binary value, bar code and combinations thereof; and, d) activating said encoding mechanism to impart said coded information on to said welding wire as said welding wire moves past said encoding mechanism.” It is the Examiner’s view that claim 1 of the instant application is completely taught on by claim 1 877 patent. In fact, the scope mentioned claim 1 of ‘877 much narrower than the subject matter disclosed in claim 1 of

the instant application. Combination of claims 1 and 2 would be equivalent to claim 1 of 877 patent.

Magnetic code is mentioned in claim 2 of the instant application and claim 3 of 877 patent.

5 Magnetic pulses having different pulse width is mentioned in claim 7 of the instant application and claim 4 of 877 patent.

Claims 9 and 10 of the instant application are identical to claims 5 and 6 of 877 patent.

The welding wire characteristics mentioned in claims 30-33 of the instant application is disclosed in claim 13 of the 877 patent.

10 Combination of claims 40-42 would equate to claim 15 of 877 patent.

Although not all aspects of the claimed subject matter is mentioned in this paragraph, it appears to Examiner that the subject matter disclosed in the presented claims are virtually identical to the claims 1-61 of 877 patent.

15 Thus, with respect to above discussions, it would have been obvious to an artisan at the time the invention was made to use the teaching of claims 1-61 of 877 patent as a general.

teaching to design a similar (if not identical) welding wire identification and parameter setting system. To the extent that the instant claim is broader and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been

20 patented.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

5 (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10 6. Claims 1, 2, 4, 9, 10, 21-25, and 30-76 are rejected under 35 U.S.C. 102(e) as being anticipated by Lanouette et al. (US 6,091,048, cited by Applicant, hereinafter “Lanouette”).

15 Re claims 1, 21-25 30-48, and 51-76 Lanouette teaches a method and apparatus for welding/arc welding (see abstract; col. 1, lines 31+) wherein various operating parameters for a particular welding conditions may be set for the welding apparatus (col. 1, lines 31+). The sensors may include wire-sensor, a barcode reader, a proximity detector, a gas sensor and other sensors (col. 1, lines 65+). The barcode information contains wire material and diameter (col. 4, lines 24-33) which can be considered an area. The coded information can broadly interpreted as a program.

20 Re claims 2 and 4, barcode is a visual marker.

Re claims 9, 10, 49, and 50, a magnetic field also can be used as a data driving the apparatus to be adjusted based on the magnetic information captured (co. 5, lines 57+). Although Lanouette is silent on tracking aspect of a product, once encoding is achieved, it is inherent that reading and decoding of information can be performed in any desired locations (i.e., another manufacturing site, distribution site, etc.).

7. Claims 3, 5, 6-8, 11-20, and 26-29, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant is kindly reminded to overcome obviousness-type double patenting rejection in paragraph 4.

5 8. The following is a statement of reasons for the indication of allowable subject matter: the claims are directed at methods and apparatus for encoding of metal welding wire with information pertaining and for controlling welding apparatus and process based on information extracted form the welding wire. As noted in continuation data, such matter is already disclosed in the parent applications, as the Applicant filed terminal disclaimer for. It is the Examiner's 10 view that most independent claims and some dependent claims are broadly recited as indicated in paragraphs 4 and 5. However, the cited references, taken alone or in combination, fail to show or fairly teach the specific method and apparatus for arc welding wherein coded information includes a magnetic code having a plurality of code segments or binary code, and the method for utilizing such information.

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*Additional Remarks*

9. Applicant is reminded to apply care in using the phrase such as "code information includes at least one code segment at least partially in the form of a pulse count, a pulse width, a pulse frequency, a program, a binary value, a bar code, a visual marker, a RFID component, an 20 IC component, a Touch Memory component, and combinations thereof." (part of claim 43). Examiner's reading of this portion is that if one is found (i.e., barcode) then this limitation is met.

***Conclusion***

5 I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Blankenship et al. (US 6,267,291); Blankenship et al. (US 6,510,984); Blankenship et al. (US 6,858,817) disclose welding wire identification systems. Applicant is respectfully suggested to carefully review these references.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

10 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

15 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

20 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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Ahshik Kim  
Patent Examiner  
Art Unit 2876  
June 24, 2005

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